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APPLICATION NO	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 845,284	05 01 2001	Chiori Mochizuki	33.C15333	3067

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[REDACTED] EXAMINER

SEFER, AHMED N

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2826

DATE MAILED: 05 22 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/845,284	MOCHIZUKI ET AL
<b>Examiner</b>	<b>Art Unit</b>	
A. Sefer	2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b)

## Status

1)  Responsive to communication(s) filed on 01 May 2002.

2a)  This action is **FINAL**.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-37 is/are pending in the application.

4a) Of the above claim(s) 6-8, 16-18 and 22-37 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5, 9-15 and 19-21 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

15. Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 132.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
4)  Interview Summary (PTO-413) Paper No(s):

## DETAILED ACTION

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-5, 9-15 and 19-21 in Paper No. 7 is acknowledged. Applicant's request for examining all of the embodiments were considered but were found to be burdensome.

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 9 cannot depend on itself.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 9, 12-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida et al. US Patent No. 5,504,348.

Semiconductor device having a plurality of functional elements formed on a substrate, an insulator (as in claims 9 and 19) comprising a slice line which is arranged along an

outer periphery of a substrate, and a peripheral wire 526 connected to a constant electric potential (as in claim 3) or ground or reference potential (as in claims 4, 12 and 14) wherein said peripheral wire has a pad section 530/S11 (as in claims 5 and 15) and arranged between said slice line and said functional elements.

5. Claims 1-5, 9-15 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Endo et al. US Patent No. 5,811,790.

Endo et al. disclose (see figs. 5 and 7 and claim 23) a semiconductor device having a plurality of functional elements carrying a fluorescent wavelength converter 401 (as in claims 10, 11, 20 and 21) formed on a substrate comprising a slice line which is arranged along an outer periphery of a substrate or an insulator (as in claims 9 and 19), and a peripheral wire connected to a constant electric potential (as in claim 3) or ground or reference potential (as in claims 4, 12 and 14) wherein said peripheral wire has a pad section 530/S11 (as in claims 5 and 15) arranged between said slice line and said functional elements.

6. Claims 1-5, 9, 12-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Henley US Patent No. 5,235,272.

Henley discloses (see fig. 2 and col. 5, lines 3-30) a semiconductor device having a plurality of functional elements formed on a substrate or an insulator (as in claims 9 and 19) comprising a slice line which is arranged along an outer periphery of a

peripheral wire has a pad section 530/21b (as in claims 5 and 15) and arranged between said slice line and said functional elements.

In regard to the slice line for cutting said substrate recited in claim 1 or the peripheral wire being used for checking recited in claims 2 and 13, an intended use of a claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Suzuki et al. US ref. 5,377,030 disclose an AMLC device capable of detecting pixel faults.
- b. Yajima et al. US ref. 5,852,480 disclose an LCD which facilitates a test for short-circuit conditions between adjacent lines.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J Flynn can be reached on (703) 308-6601.

ANS  
May 16, 2002



NATHAN J. FLYNN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800